



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,665	11/13/2001	Kaia Palm	CEMINES.002A	8494

24113 7590 03/15/2006

PATTERSON, THUENTE, SKAAR & CHRISTENSEN, P.A.  
4800 IDS CENTER  
80 SOUTH 8TH STREET  
MINNEAPOLIS, MN 55402-2100

EXAMINER

UNGAR, SUSAN NMN

ART UNIT PAPER NUMBER

1642

DATE MAILED: 03/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	Application No. 09/992,665	Applicant(s) PALM, KAIA	
	Examiner Susan Ungar	Art Unit 1642	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 15 November 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☒ They raise the issue of new matter (see NOTE below);  
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

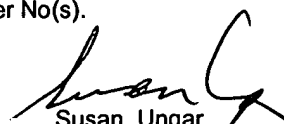
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: none.  
Claim(s) objected to: none.  
Claim(s) rejected: 67-73, 75-81 and 96.  
Claim(s) withdrawn from consideration: 74, 82-95 and 97-134.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s).  
13. ☒ Other: See Continuation Sheet.

  
Susan Ungar  
Primary Examiner  
Art Unit: 1642

Continuation of 3. NOTE: Claim 67 and various other claims as disclosed have been amended to be drawn to testing a host for a plurality of transcription factor types which is an issue that requires further consideration and or search.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's reiterates arguments drawn to the limitation of examination of the elected invention and further argues that the claims as amended are not limited to the elected invention. The argument has been considered previously and not found persuasive for the reasons of record. Further, Applicant's arguments drawn to the newly amended claims have been considered but have not been found persuasive because the claims have not been entered. Applicant points to *Atlas Powder v Dupont* and states that even if some of the claimed combinations are inoperative, the claims are not necessarily invalid. The argument has been considered but has not been found persuasive because it is the elected invention that is not enabled for the reasons of record. Applicant reiterates arguments drawn to restriction practice and points specifically to species restriction practice. The arguments have been considered previously and have not been found persuasive for the reasons of record. Examiner once again suggests that Applicant review MPEP 804.01 for further information on linking claim restriction practice. Applicant argues that the Office did not show good reasons why the claims are not enabled. The argument has been considered but has not been found persuasive because Examiner clearly presented evidence from Applicant's own specification clearly demonstrating that the claimed invention is not enabled. Applicant argues that amendment of the claims to recite "each of the plurality of transcription factor types are chemically distinct from each other" obviates the rejection under 35 USC 102(b). The argument has been considered but is found moot because the newly amended claims have not in fact been entered.

Continuation of 13. Other: It is noted that the Information Disclosure Form filed November 17, 2005 has been placed in the file but has not and will not be considered. Applicant states that the Information disclosure is an initialed copy of the form submitted on October 18, 2005. It is noted that no Information disclosure form dated October 18, 2005 is found in the file. Given that Applicant states that the November 17 form is a copy of the October 18 form, Examiner is assuming for examination purposes that two forms are identical and has determined that the submission does not meet the requirements of 37 CFR 1.97(d) and (e) because contrary to Applicant's statement, neither the October 18 form nor the November 17 form were submitted prior to the mailing of a Final Action. It is noted for Applicant's convenience that the Final Rejection in this case was mailed on September 15, 2005. Further, although Applicant submitted the required fee, an IDS will not be considered After Final in the absence of the required statement disclosed in CRF 37 1.97(d)